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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/723,189	11/27/2000	Gerhard Benner	Beiersdorf 670	5654

7590

08/08/2003

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EXAMINER

HAGHIGHATIAN, MINA

ART UNIT

PAPER NUMBER

1616

DATE MAILED: 08/08/2003

19

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/723,189

Applicant(s)

BENNER ET AL.

Examiner

Mina Haghighatian

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 22 May 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1, 6, 7 and 9-11 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1, 6-7, 9-11 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

### **DETAILED ACTION**

The amendment filed 05/22/03 was entered. No new claims were added, and claims 2-5 and 8 were cancelled.

### ***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1, 6-7 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ascione et al (5,858,334) in view of Gohla et al (5,750,124).

Ascione teaches stable and homogenous, topically applicable cosmetic compositions well suited for artificially tanning human skin, comprise a storage-stable, ultrafine oil-in-water emulsion, wherein the average particle size of the globules comprising the oily phase of the emulsion characteristically ranges from 100 nm to 1000 nm (see abstract and col. 2, lines 30-37). The ultrafine oil-in-water emulsions are themselves preferably obtained via the so called "phase inversion" technique (col. 1, lines 65-66). The oil-in-water emulsions may contain oils such as mineral oils, vegetable oils such as karite butter (also known as shea butter) or synthetic oils in the fatty phase (col. 2, lines 41-64).

Ascione discloses that the oily phase comprises from 5 to 50% by weight of the total weight of the composition. Ascione also discloses the preferred emulsifiers for the said emulsions, which are in the concentration range from 0.5 to 20% by weight of the

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total composition (col.3, line 47 to col. 4, line 23). Ascione lacks specific teachings on the properties of emulsifiers.

Gohla teaches multiple emulsions comprising at least one emulsifier whose lipophilicity increases with increasing temperature and hydrophilicity of which increases with decreasing temperature, the emulsifiers changing from an HLB value  $<10$  to an HLB value of  $>10$  in the temperature range of 40-90 degrees centigrade, the HLB value of the emulsifier or emulsifiers at room temperature being between 11 and 18, the emulsifier not being completely soluble in the oily phase; also optionally further auxiliaries and/or additives to stabilize the multiple emulsion droplets; and other additives and/or active compounds customary in cosmetics or medical preparations, (see abstract and col. 11, lines 9-67).

Gohla also discloses oil phase to be formed from oils such as mineral oil and vegetable oils such as wheatgerm oil, grapeseed oil etc (see examples 1-11). Process of preparing oil-in-water emulsions are described in column 12, lines 28-39.

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have modified the composition of Ascione, an emulsion containing karite butter, by using the teachings of Gohla on the emulsions containing emulsifiers with such specific properties, because of the expectancy of producing composition systems which are stable microscopically over relatively long storage times or in a wide temperature range or towards extreme variations in temperature.

Claims 1, 6-8 and 9-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gohla et al (5,750,124) in view of applicant's admission.

Gohla, discussed above, lacks specific disclosure of shea butter.

Applicant admits, in the specification, page 10, lines 13-16, that shea fat and shea fat fractions have been known in skincare for a long time for their care and protecting properties. The action of these fatty substances is attributed to an influencing of biochemical inflammation processes since the UV absorption in the UVA and UVB region is only weakly defined. Applicant also admits that shea butter is commercially available (page 9).

It would have been obvious to a person of ordinary skill in the art at the time the invention was made to have prepared the emulsion of Gohla, and substituted shea butter for vegetable oils because of known properties and benefits of shea butter in care and protection of skin, and with the reasonable expectation of obtaining a skincare formulation which has the combined properties of the emulsifiers and shea butter.

***Response to Arguments***

Applicant's arguments filed 05/22/03 have been fully considered but they are not persuasive.

Applicant argues that the prior art of record, Ascione, is directed towards macroemulsions and does not teach microemulsions. This is not persuasive because according to general knowledge and applicant's disclosure (specification, pages 7-8), microemulsions are in the range of about  $10^{-2} \mu\text{m}$  to about  $10^{-1} \mu\text{m}$ . Ascione discloses that the oil-in-water emulsions are in the range of 100 to 100nm, therefore this limitation is met.

Applicant argues that Ascione does not disclose an effective amount for the shea butter. This is not persuasive because Ascione, in column 3, lines 47-67 discloses the preferred concentration ranges for each component of the composition, which includes oily phase comprising shea butter. This range is said to be from 5-50%, which meets the required range by the application.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mina Haghighatian whose telephone number is 703-308-6330. The examiner can normally be reached on core office hours.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page can be reached on 703-308-2927. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-308-4242 for After Final communications.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0198.

Mina Haghighatian  
August 4, 2003

  
MICHAEL G. HARTLEY  
PRIMARY EXAMINER